

REMARKS

New claims 30 to 33 are added, and therefore claims 15 to 19 and 21 to 33 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Claims 28, 15, 17, and 27 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0063796 to Min et al. ("Min"). The Min reference does not anticipate any of the present claims, and the present rejection should be withdrawn, for at least the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. *See Lindeman Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. *See Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also **enable** a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

Claim 28 relates to a method for generating a counter in a receiving device for digital data streams, and provides for "generating the digital data streams in a transmitting device **by sampling analog signals at a sampling frequency synchronized by a system time clock in the transmitting device.**" The Min reference does not disclose or suggest this feature. Although the Office Action alleges that paragraph [0006] of the Min reference teaches the above-recited feature, the cited section does not support the Office Action's contention. Any review of the Min reference makes plain that **sampling analog signals**, let alone at a sampling frequency synchronized by a system time clock in the transmitting device, as provided in the context of the claimed subject matter, is not discussed at all. Instead, paragraph [0006] specifically discloses "encoding and decoding ... and reproduction of **digital** data." Any speculation that "the sampling frequency is referring to the sampling frequency used by an analog to digital converter to generate [a] digital signal," as asserted by the Office Action, is unsustainably beyond the scope of the Min reference.

To the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). In this regard, the Office Action concedes that “Min does not expressly disclose converting the signal to digital from analog” but speculates that “it appears that the sampling frequency is referring to the sampling frequency used by an analog to digital converter...” (*Office Action*, page 2, paragraph 3.) However, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Still further, claim 28 provides for “**determining the sampling frequency of one of the data streams in the receiving device.**” The Min reference does not identically disclose, or even suggest, this feature. Instead of determining the sampling frequency, this information is provided in the transmitted signal. In this regard, the Min reference states the following:

When a digital signal is encoded into data packets for transmission as system bit streams, **clock reference values** which represent values of an encoder counter clocked by a stable clock having a frequency that is proportional to the sampling frequency of the digital signal to be transmitted, **are encoded together with the digital signal** ... producing a decoder clock using the **clock reference values contained in the data packets.**

(*The Min reference*, paragraph [0006], emphasis added.) Accordingly, the Min reference does not disclose, or even suggest, the feature of determining the sampling frequency of one of the data streams in the receiving device,” as provided in the context of claim 28.

For all of the foregoing reasons, the Min reference does not identically disclose or suggest all of the features of claim 28. Accordingly, claim 28, as well as its dependent claims 15, 17, and 27, are allowable.

Withdrawal of this anticipation rejection is therefore respectfully requested.

Claims 16, 18, and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Min reference.

To reject a claim as obvious under 35 U.S.C. § 103, the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532,

28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied.

First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1741.

Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Office Action does not satisfy these requirements as to all of the features of the claims.

Claims 16, 18 and 19 ultimately depend from claim 28 and are therefore allowable for at least the same reasons as claim 28, because, as discussed above, the Min reference does not disclose or suggest the feature of “sampling analog signals” as well as “determining the sampling frequency of one of the data streams in the receiving device,” as provided in the context of claim 28.

Withdrawal of this obviousness rejection of claims 16, 18, and 19 is therefore respectfully requested.

Claims 29 and 21 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Min reference in view of U.S. Patent No. 6,363,207 to Duruoz et al. (“Duruoz”).

Claim 29 relates to a receiving device and provides for “a unit for correctly **determining a sampling frequency** of one of the packetized elementary data streams.” It is respectfully submitted that the Min reference does not disclose or suggest this feature. Instead, as explained above in the context of the patentability of claim 28, the Min reference refers only to the inclusion of time information with the transmitted packetized elementary

data streams. Any review of paragraph [0006] of the Min reference, (cited by the Office Action as assertedly disclosing this feature,) and any other section of the entire Min reference, makes plain that determining a sampling frequency, as provided in the context of claim 29, is not disclosed or suggested in the Min reference. The secondary Duruozy reference does not cure – and is not asserted to cure – this critical deficiency.

Accordingly, the combination of the Min and Duruozy references does not disclose or suggest all of the features of claim 29, so that the combination of the Min and Duruozy references does not render unpatentable claim 29 or any of its dependent claims 21 to 26.

As further regards dependent claim 21, it provides that “the synchronization unit sets an increment of the counter, the increment being determined from a **ratio** between a program clock reference and a nominal sampling frequency.” The Office Action asserts that the Min reference discloses the above feature. In particular, it states that the “STC counter is adjusted by the difference ... between the program clock reference value ... and the sampling frequency.” (*Office Action*, page 6.) It is respectfully submitted that “difference” is wholly different from “ratio.” Accordingly, the Min reference does not disclose or suggest all the features of claim 21. The secondary Duruozy reference does not cure – and is not asserted to cure – this critical deficiency. For this additional reason claim 21 is allowable.

Withdrawal of this obviousness rejection of claims 29 and 21 to 26 is therefore respectfully requested.

New claims 30 to 33 have been added herein. Claims 30 to 33 do not add new matter and are supported by the application, including Specification, as originally filed. Claims 30 to 33 ultimately depend from claim 28 and are therefore allowable for at least the same reasons as claim 28.

Accordingly, all of pending claims 15 to 19 and 21 to 33 are in condition for immediate allowance.

Conclusion

In view of the foregoing, it is respectfully submitted that all of pending claims 15 to 19 and 21 to 33 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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